

REMARKS

Reconsideration of the above-identified patent application in view of the amendments above and the remarks following is respectfully requested.

Claims 8-10, 13, 18 and 23 are pending in this application. Claim 13 is independent. Claims 8-10, 13, 18 and 23 have been rejected under § 103(a). Independent claim 13 has been amended. New dependent claims 24 and 25 have been added.

Specifically, claim 13 has been restored to its condition before the filing of the Notice of Appeal of February 21, 2006, and then has been amended to recite the limitation that the first port is situated, not at an exterior edge of the system board, facing outward from the exterior edge, but at an outermost exterior boundary of the system board, facing outward from the outermost exterior boundary. The limitations deleted from claim 13 in restoring claim 13 to its condition before the filing of the Notice of Appeal have been re-introduced in new dependent claims 24 and 25. Support for the new limitation of claim 13 is found in the patent application as filed, at least in Figures 4 and 5 and the description thereof in the specification. Figure 5 shows that connector 70 is at the outermost exterior boundary of system board 80. Figure 4 shows connector 70 with port 72 thereof facing outward (see patent application as filed, page 6 lines 4-7).

§ 103(a) Rejections – Meng ‘399 in view of Zhu et al. ‘833

The Examiner has rejected claim 8-10, 13, 18 and 23 under § 103(a) as being unpatentable over Meng, US 6,231,399 (henceforth, “Meng ‘399”) in view of Zhu et al., US Patent No. 6,142,833 (henceforth, “Zhu et al. ‘833”). The Examiner’s rejection is respectfully traversed.

Because the Examiner actually cited Zhu et al. '833 only against dependent claim 23, the following discussion will assume that independent claim 13 has been rejected as unpatentable over only Meng '399.

The Examiner interprets Meng '399 as teaching a system board connector 10 that includes two ports 14 and 16, with port 16 facing inward to the interior of the system board. The Examiner also has noted that Meng '399 teaches (column 3 lines 3-5) that

...changes may be made in detail, especially in matters of shape, size, and arrangement of parts within the principles of the invention...

Even accepting for the sake of argument the correctness of the Examiner's interpretation, in the Decision of the Board of Patent Appeals and Interferences that was mailed on September 5, 2007, the specific modification recited in claim 13 was deemed by the Appeal Board to be not obvious from Meng '399. (A copy of this Decision is attached for the convenience of the Examiner.)

Specifically, in the Appeal Brief filed March 9, 2006, Applicant argued, on page 14 lines 22-29, that the "changes" referred to by Meng '399

...must be within the principle of the invention, which is to position two daughter boards parallel to the mother board, inside the computer, far enough from the mother board to not interfere with the components on the mother board. There is neither a hint nor a suggestion in Meng '399 of positioning card edge connector assembly 10 with one of the card edge connectors facing outward from an exterior edge of the mother board, even though this, too, would solve the problem addressed by Meng '399, by placing one of the daughter boards outside the computer, or at least laterally beyond the mother board.

The Appeal Board agreed with this analysis of Meng '399. Specifically, in page 3 lines 18-19 of the Decision, the Appeal Board wrote:

... we agree with Appellant that Meng requires the connector to be inside the computer, (emphasis added)

While the Decision also stated that the claims as then written did not “require the [first port of the] connector to be located at the outermost [exterior] boundary of the system board” (page 3 lines 19-20), the Decision made clear that if the claims did require the (first port of the) connector to be located at the outermost (exterior) boundary of the system board, they would be non-obvious over and patentable with respect to Meng ‘399 (see first two paragraphs of “Opinion,” pages 2-4). Since claim 13 has been amended herein to require the first port of the connector to be located at the outermost exterior boundary of the system board, it is submitted that claim 13 is patentable over Meng ‘399.

With independent claim 13 allowable in its present form it follows that claims 8-10, 18 and 23-25 that depend therefrom also are allowable.

Drawings

The Examiner has objected to Figure 5 as appearing to show device 90 connected to North Bridge controller 3.

In a telephonic interview on December 10, 2008, the Examiner recommended adding a drawing showing the motherboard of Figure 5 in cross-section, with element (DiskOnKey™ flash memory) 90 detached from North Bridge controller 3. Attached please find a such new Figure 6 that shows element 90 connected only to connector 70 and not to North Bridge controller 3. The support in the patent application as filed for new Figure 6 is discussed below in the context of the amendments to the specification. Attached also please find a replacement Figure 5 showing the location of the cross-section of new Figure 6, and with an inadvertent typographical error (reference numeral “52” instead of reference numeral “70”) corrected.

Amendments to the Specification

As described above, new Figure 6 has been added to show that element (DiskOnKey™ flash memory) **90** is not connected to North Bridge controller **3**. The text of the specification has been amended to reflect the addition of new Figure 6.

Evidence for the support in the patent application as filed for DiskOnKey™ flash memory **90** being connected only to connector **70** and hence not to North Bridge controller **3**, was presented in the response, filed June 20, 2005, to the Office Action mailed March 22, 2005. For the convenience of the Examiner, this evidence is repeated here.

It was known in the art on the priority date of the above-identified patent application that a DiskOnKey™ flash memory (element **90**) has only one interface, a USB interface via which the DiskOnKey™ flash memory exchanges electrical signals with and receives electrical power from the device to which the DiskOnKey™ flash memory is connected. That this is true may be seen by reference to the attached five Exhibits, of which: Exhibit A is a circuit diagram of a DiskOnKey™ flash memory dated June 4, 2002, showing that the only external interface of the DiskOnKey™ flash memory is the “USB_A_MALE” interface in the lower center of the circuit diagram; Exhibit B is a top view of a DiskOnKey™ flash memory with its cover removed; Exhibit C is a bottom view of a DiskOnKey™ flash memory with its cover removed; Exhibit D is a line drawing corresponding to Exhibit B and dated May 15, 2002; and Exhibit E is a line drawing corresponding to Exhibit C and dated May 15, 2002. As seen in the attached Exhibits, each of Exhibits A, B, D and E is labeled “TITIN” or “TITAN”, which was the internal name of the DiskOnKey™ project of M-Systems Flash Disk Pioneers, Ltd. of Kfar Saba, Israel, the former assignee of the above-identified patent application. This attests to the fact that the circuit diagram of Exhibit

A is a diagram of the circuit of the DiskOnKey™ flash memory shown in Exhibits B-E. Since the DiskOnKey™ flash memory has only a single external interface, namely, a USB_A_MALE interface, it follows that, as illustrated in Figures 5 and 6, DiskOnKey™ flash memory 90 could be electrically connected to system board 80 via only one of the USB ports (72, 74) of system board 80. Since as stated in the originally filed disclosure (patent application as filed, page 6 lines 11-14), DiskOnKey™ flash memory 90 is connected to USB port 74 of system board 80, it follows that DiskOnKey™ flash memory 90 is not connected to North Bridge controller 3.

No new matter has been added.

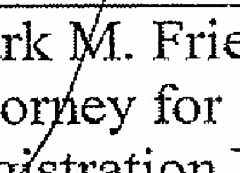
Information Disclosure Statement

The Examiner has objected to the Information Disclosure Statement filed February 6, 2008 as lacking a legible copy of JP 11067392.

An Information Disclosure Statement with a legible copy of JP 11067392 was filed on November 19, 2008.

In view of the above amendments and remarks it is respectfully submitted that independent claim 13, and hence dependent claims 8-10, 18 and 23-25 are in condition for allowance. Prompt notice of allowance is respectfully and earnestly solicited.

Respectfully submitted,



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